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EXAMINER

LIU, MING HUN

ART UNIT PAPER NUMBER

2675

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No. ☒

09/955,059

Applicant(s)

HATANAKA ET AL.

Examiner

Ming-Hun Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38, 43-83, 88-128 and 133-135 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-28, 30-38, 43-60, 62-63, 65-83, 88-108, 110-128 and 133-135 is/are rejected.
- 7) ☒ Claim(s) 19, 29, 61, 64 and 109 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 5, 25, 50, 70 and 115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what the definition of “margin” is in the context of the invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-9, 11-18, 20-24, 26-28, 30-38, 43-49, 51-54, 56-60, 62-63, 65-69, 71-81, 83, 88-108, 110-114, 116-126, 128 and 133-135 are rejected under 35 U.S.C. 102(e) as being unpatentable by US Patent 6,615,408 to Kaiser et al.

In reference to claims 1 and 91, Kaiser teaches a control system for controlling a display device including a display unit (1200) displaying a motion picture, and a pointing unit (1700) pointing a position on the motion picture. Included in Kaiser's invention is a recognizing unit (1330) recognizing an object in the motion picture on which the pointing manipulation is effected; and a processing unit executing a predetermined process related to the object recognized (1300; column 8, lines 1-30).

In reference to claims 2 and 92, Kaiser teaches a control system where the receiving unit (1310) receives first data (placement zone) containing the motion picture and second data (trigger zone) related to the object in the motion picture contained in the first data, and said processing unit (1300) makes said display device output the second data related to the object recognized (column 6, lines 9-40).

In reference to claims 3 and 93, Kaiser teaches a system that wherein the second data contains an image related to the motion picture of the first data (column 9, lines 1-16).

In reference to claims 4 and 94, Kaiser teaches a system wherein the second data is multiplexed with the first data and thus distributed (column 6, lines 51-52).

In reference to claims 5 and 95, Kaiser teaches a control system wherein the second data is embedded in a margin of the first data (53-54).

In reference to claims 6 and 96, Kaiser teaches a system where the motion picture of the first data contains an image related to a commercial article or a service becoming an advertisement target, and the second data is an advertisement of the article or the service (column 9, lines 1-7).

In reference to claims 7 and 97, Kaiser teaches a system where the processing unit executes an application program related to the object recognized (figure 8; column 12, lines 1-10).

In reference to claims 8 and 98, Kaiser teaches a control system wherein the processing unit executes a task related to the object recognized (column 11, lines 16-18).

In reference to claims 9 and 99, Kaiser teaches a control system according to display device further includes a communication unit (1300) transmitting a command to other task

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executing device, and the processing unit, via the communication unit device to execute a task commands other task executing related to the object recognized (column 5, lines 45-49).

In reference to claims 11 and 101, Kaiser teaches a control system wherein the display device further includes a communication unit transmitting information to an add-up server adding up pieces of information (column 14, lines 12-13), and said processing unit via the communication unit, notifies said add-up server of the information related to the recognized object, and makes said add-up server add up results of the recognition (column 8, lines 18-21).

In reference to claims 12 and 102, Kaiser teaches a system wherein the motion picture formed of a plurality of frames (column 6, line 20), the receiving unit (1310) further receives definition information for defining an area of the object of each frame and the recognizing unit (1330) collates a position on the motion picture receiving the pointing manipulation with the definition information with respect to the frame of the motion picture receiving the pointing manipulation (column 6, lines 30-40).

In reference to claims 13, 58 and 103 it can be seen from figures 6a and 6b that the display shows the motion pictures with enhancement.

In reference to claims 14 and 104, Kaiser teaches a control system wherein the receiving unit further receives information for describing a characteristic of the object, and the processing unit generates an object corresponding to the motion picture on the basis of the motion picture and the information for describing the characteristic of the object (column 10, lines 1-12).

In reference to claims 15 and 105, Kaiser teaches a control system wherein when the pointing manipulation occurs during the display of the motion picture contained in the first data, the processing unit, after an end of displaying the motion picture, commands the display device

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to output the second data related to the object recognized by the pointing manipulation (column 10, lines 20-50).

In reference to claims 16 and 106, Kaiser teaches a control system according to display device further includes a recording unit (item 1600) recording data and the processing unit, when the object is recognized from the pointing manipulation during the display of the motion picture, commands said recording unit to record the second data related to the object, and after the end of displaying the motion picture, commands said display device to output the second data recorded (program guides – column 14, line 2).

In reference to claims 17 and 107, Kaiser teaches a control system according wherein the processing unit, when the object is recognized from the pointing manipulation during the display of the motion picture contained in the first data, commands said display device to effect a first changeover to an output of the second data related to the object (figure 4, if branch 5500; column 9, lines 47-56).

In reference to claims 18 and 108, Kaiser teaches a control system according to claim 17, wherein the processing unit commands the display device to executes a second changeover to displaying the motion picture after outputting the second data (figure 4 and figures 6a-d).

In reference to claims 20 and 110, Kaiser teaches control system that includes a first receiving unit receiving the first data and a second receiving unit receiving the second data (1380 and 1360).

In reference to claim 21, the majority of this claim is rejected by the reasoning outlined in the rejection of claim 1. Kaiser also anticipates the unaddressed limitations of this claim. Kaiser teaches a communication unit (figure 5 and item 1300) transmitting the position on the motion

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picture receiving the pointing manipulation to a server including a unit recognizing an object in the motion picture receiving the pointing manipulation, and receiving, from the server (1400), information on the object in the motion picture recognized by the server (column 9, lines 48-56).

Claim 22 is rejected on the grounds outlined in the rejection of claim 2.

Claim 23 is rejected on the grounds outlined in the rejection of claim 3.

Claim 24 is rejected on the grounds outlined in the rejection of claim 4.

Claim 26 is rejected on the grounds outlined in the rejection of claim 7.

Claim 27 is rejected on the grounds outlined in the rejection of claim 8.

In reference to claim 28, Kaiser teaches a control system wherein the processing unit commands other task executing device to execute a task related to the object recognized via said communication unit (column 9, lines 48-56).

Claim 30 is rejected on the grounds outlined in the rejection of claim 11.

Claim 31 is rejected on the grounds outlined in the rejection of claim 16.

In reference to claim 32, Kaiser teaches a server (figure 1, 1400) in linkage with a display device including a receiving unit (1310) receiving data containing a motion picture, a display unit (1200) displaying the motion picture, and a pointing unit pointing a position on the motion picture (1700), said server comprising: a communication unit (1300) receiving information the position where the pointing manipulation is effected from said display device; a recognizing unit recognizing the object (1330) in the motion picture receiving the pointing manipulation on the basis of the information received from said display device; and a processing unit (1300) executing a predetermined process related to the object recognized.

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In reference to claim 33, it can be seen from the figures 1 and 3 that the processing unit (1300) transmits the information on the object recognized to the display device via the communication unit (1300).

Claim 34 is rejected on the grounds outlined in the rejection of claim 27.

Claim 35 is rejected on the grounds outlined in the rejection of claim 28.

Claim 36 is rejected on the grounds outlined in the rejection of claim 30.

Claim 37 is rejected on the grounds outlined in the rejection of claim 10.

Claim 38 is rejected largely on the grounds outlined in the rejection of claim 32. Please refer to that rejection. In reference to the added limitations of referring unit and commanding unit, Kaiser also anticipates such limitations. Specifically, Kaiser teaches a referring unit referring to an instruction related to the object (column 1320) and a commanding unit commanding the data distribution system to change over the data to be distributed in accordance with the instruction (1500, column 8, lines 39-45).

Claims 43 and 44 are rejected largely on the grounds outlined in the rejection of claims 1, 2, and 11. The section of claims 43 and 44 that remains unaddressed deals with a "recording unit, if unable to recognize the object with respect to the point manipulation, recording data on that position." What Kaiser does disclose is that the recorded user profile data maybe include both information explicitly supplied (recognized actions) by the user and information derived form the user's pattern of usage for example "the frequency of performing the different interactive actions" (column 14, lines 3-21).

In reference to claim 45, Kaiser teaches a display device comprising: a receiving unit receiving data containing a motion picture from a data distribution system (figure 3, item1310), a

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display unit displaying the motion picture (1200), a pointing unit pointing a position on the motion picture (figure 1, item 1700) and a communication unit (1300) communicating with a server (1400) for recognizing an object in the motion picture. When a motion picture of first data displayed on the display unit receives the pointing manipulation transmits, to the server, a piece of information about a position on the motion picture receiving the pointing manipulation and a piece of information for specifying the motion picture, the server commands said data distribution system to change over the data to be distributed in accordance with the position on the motion picture receiving the pointing manipulation (column 9, lines 48-56), the receiving unit receives second data changed over, and said display unit displays the second data (figure 5).

In reference to claims following claims concerning a "storage medium readable by a machine", Kaiser teaches in embodiment described in figure 10, the same invention where the "action resource provider 1500 may be structures in accordance with the computer system" (column 13, line 19-21). Therefore, described the reasoning used to reject the claimed server systems/control system for the preceding are taught by Kaiser as being able to be used on the local machine.

In reference to claims 46, 66, 76, 77, 111 and 122, Kaiser teaches a storage medium readable by a machine (10045). tangible embodying a program of instructions executable by the machine including a communication unit (10030) so as to control a display device including a display unit (10060) displaying a motion picture and a pointing unit (10090) pointing a position on the motion picture, to perform method steps comprising transmitting the position on the motion picture receiving the pointing manipulation to a server including a recognizing unit

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recognizing an object in the motion picture receiving the pointing manipulation (column 8, lines 1-30); receiving from the server, information on the object in the motion picture recognized by the server; and executing a predetermined process related to the object recognized (column 13, lines 60-67).

Claims 47, 67 and 112 are rejected on the grounds outlined in the rejection of claim 2.

Claims 48, 68 and 113 are rejected on the grounds outlined in the rejection of claim 3.

Claims 49, 69 and 114 are rejected on the grounds outlined in the rejection of claim 4.

In reference to claims 51, Kaiser teaches on that the motion picture of the first data contains an image related to a commercial article or a service becoming an advertisement target, and the second data is an advertisement of the article or the service (column 7, lines 5-15).

Claims 52, 71, 116 and 123 are rejected on the grounds outlined in the rejection of claim 7.

Claims 53, 72, 79, 117 and 124 are rejected on the grounds outlined in the rejection of claim 8.

Claims 54, 73, 80, 118 and 125 are rejected on the grounds outlined in the rejection of claim 9.

Claims 56, 75, 81, 120 and 126 are rejected on the grounds outlined in the rejection of claim 11.

Claim 57 is rejected on the grounds outlined in the rejection of claim 12.

Claim 59 is rejected on the grounds outlined in the rejection of claim 14.

Claim 60 is rejected on the grounds outlined in the rejection of claim 15.

Claim 62 and 83 are rejected on the grounds outlined in the rejection of claim 17.

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Claim 63 is rejected on the grounds outlined in the rejection of claim 18.

Claim 65 is rejected on the grounds outlined in the rejection of claim 20.

In reference to claims 74 and 119, Kaiser teaches a display device includes a reproducing unit reproducing the motion picture recorded on a recording medium, said recording medium is recorded with a first motion picture and a second image related to an object corresponding to the first motion picture (column 9, lines 3-17). Kaiser also teaches that the predetermined process involves reproducing from said recording medium the second image related to the object recognized and making said display device display the reproduced second image (column 9, lines 48-56).

Claim 78 is rejected on the grounds outlined in the rejection of claim 6.

Claims 88, 89 133 and 134 are rejected on the grounds outlined in the rejection of claims 43 and 66.

Claim 90 is rejected on the grounds outlined in the rejection of claims 45.

In reference to claim 121, Kaiser teaches on column 9, lines 48-56, reproducing the motion picture recorded on recording medium, wherein said transmitting involves, when the motion picture to be reproduced receives the pointing manipulation, transmitting, to said server information for specifying this motion picture and information for specifying a position where the pointing manipulation is effected on the motion picture.

Claim 128 is rejected largely on the grounds outlined in the rejection of claims 122 and 17.

Claim 135 is rejected on the grounds outlined in the rejection of claims 45, 17 and 18.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 55, 82, 100 and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiser in view of US Patent 6,847,969 to Mathai et al.

In reference to claims 10, 55, 82, 100 and 127 Kaiser teaches an advertising system that resembles the claimed invention, however Kaiser's invention does not explicitly include the task executing device is an E-mail server delivering an E-mail.

Mathai teaches on column 5, lines 16-17 an advertising system that allows for the transfer of emails.

Kaiser's invention could be modified to resemble the claimed invention by including Mathai's email communication element.

It would have been obvious to one skilled in the art to include email functions to the advertising system so as to diversify the avenue of communication. The combination of the two references is further justified by the Kaiser's disclosure of supporting advertising linkages using "HTML, XML, scripts, programs... and analogous instructing information languages" (column 5, lines 59 –63). As one skilled in the art understands HTML, XML and scripts, program and such are general forms of Internet communication and thus encompass the specific form of Internet email.

Allowable Subject Matter

6. Claims 19, 29, 61, 64, and 109 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,708,845 to Wistendahl et al

US Patent 6,374,228 to Litwin

US Patent 6,801,575 to Crinon

US Patent 6,616,533 to Rashkovskiy

US Patent 6,714,215 to Flora et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on 571-272-3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu


SUMATI LEFKOWITZ
PRIMARY EXAMINER